

UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL D. ZOECKLER

Application 09/559,704

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on August 8, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) indicates that in the Final Rejection mailed February 5, 2004, the Non-Final Rejection mailed April 5, 2004; and the Non-Final Rejection mailed August 25, 2004, the following rejections are listed:

1. Claims 1-3, 11-16, 25-29 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Stone (US 5,551,938);

2. Claims 1, 3-5, 7, 9-11, 16, 25, 29-32, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Lang (US 5,147,480); and

3. Claims 4-7 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone (US 5,551,938) in view of Stokes (US 1,880,288).

Appellants reiterated these grounds of rejection on page 9 of the Substitute Amended Appeal Brief filed February 2, 2005. In the Examiner's Answer mailed February 24, 2005, however, the examiner lists the following rejections:

1. Claims 1-3, 11-16, 25-29, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Stone (US 5,551,938);

2. Claims 1, 3-5, 7, 9-11, 16, 25, 29-32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang (US 5,147,480) in view of Campbell et al. (US 1,600,396); and

3. Claims 4-7 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone (US 5,551,938) in view of Stokes (US 1,880,288).

It appears that the § 103(a) rejection of claims 1, 3-5, 7, 9-11, 16, 25, 29-32, and 34 listed above is a new ground of rejection. As of September 13, 2004, new grounds of rejection may be included in the Examiner's Answer. The new rule reads as follows:

§ 41.39 Examiner's answer.

(a)(1) The primary examiner may, within such time as may be directed by the Director, furnish a written answer to the appeal brief including such explanation of the invention claimed and of the references relied upon and grounds of rejection as may be necessary, supplying a copy to appellant. If the primary examiner determines that the appeal does not comply with the provisions of §§ 41.31 and 41.37 or does not relate to an appealable action, the primary examiner shall make such determination of record.

(2) An examiner's answer may include a new ground of rejection.

(b) If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief

as set forth in § 41.41. Such a reply brief must address each new ground of rejection as set forth in § 41.37(c)(1)(vii) and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

(c) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

In order to include a new ground of rejection in the Examiner's Answer, the examiner must follow the guidelines set forth in training material entitled "Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule," located at the following URL:

www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html

The requirements for a new ground of rejection are:

1) Approval by a Technology Center Director or designee; and

2) Prominently identified, by a separate heading with all capital letters in the following sections of the Examiner's Answer:

Grounds of Rejection to be Reviewed on Appeal section,
and

Grounds of Rejection section.

To correct this problem, the examiner will need to vacate the Examiner's Answer mailed February 24, 2005. Once the Examiner's Answer mailed February 24, 2005 is vacated, the examiner has the following options:

- 1) to write a new Examiner's Answer without the new grounds of rejection;
- 2) to reopen prosecution; or
- 3) to write a new Examiner's Answer properly setting forth the new grounds of rejection.

Accordingly, it is

ORDERED that the application is returned to the examiner to:

- 1) vacate the Examiner's Answer mailed February 24, 2005;

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- 2) to select one of the following options:
 - a) reopen prosecution;
 - b) write a new Examiner's Answer without the new grounds of rejection; or
 - c) write a new Examiner's Answer properly setting forth the new ground of rejection;
- 3) to have a complete copy of any subsequent Examiner's Answer scanned into the IFW; and
- 4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
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